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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/019,669      | 05/13/2002  | H. Darrel Darby      | A7705               | 6168             |

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EXAMINER

PATTERSON, MARIE D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/019,669

Applicant(s)

DARBY, H. DARREL

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 33 and 34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 6, 9, 12-30 and 35-40 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7, 8, 10, 11, 31, and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Claims 26-30, 37, 39, and 40 have been rejoined and examined due to the allowability of claims 25, 35, and 38 from which these claims depend.
2. Claims 33 and 34 remain withdrawn as directed towards a nonelected invention.

IT is noted that these claims depend from claim 32 which is not patentable/allowable and therefore there is no inventive concept present.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 5, 7, 8, 10, 11, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbe (5491909) in view of Darby (5370133) and Grim (5329705).

Darby '909 shows a shoe comprising an outsole (16), an upper (14), an insole assembly (18), and a shank (22) substantially as claimed except for the sole having a circumferential counter portion and the exact layered insole. Darby '133 teaches providing an outsole with a circumferential counter portion (shown as 16A in figure 1). Grim teaches providing an insole with a plurality of different layers (52, 64, and 56) which are separably removable and are "capable of being rearranged in a different order" (due to the layers being completely detachable from one another) and one having a removable area (68) for use in a medical shoe. It would have been obvious to provide

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the outsole with a counter portion as taught by Darby '133 and to provide an insole having a plurality of different separable layers as taught by Grim in the shoe of Darby '909 to provide greater stability to the outsole/upper construction and to increase the cushioning and medial benefits of the insole construction taught by Grim.

5. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2, 4, 5, 7, 8, 10, 11, and 31 above, and further in view of Kellerman (5799414).

Darby '909 as modified above shows an insole assembly substantially as claimed except for skiving the edges of the oval area. Kellerman teaches skiving/chamfering the edges of an opening (see column 5 lines 27-46). It would have been obvious to skive/chamfer the edges of the opening as taught by Kellerman in the insole assembly of Darby '909 as modified above to provide a smooth transition and to make the removable portion easier to remove.

***Allowable Subject Matter***

6. Claims 3, 6, 9, 12-30, and 35-40 are allowed.

***Response to Arguments***

7. Applicant's arguments filed 6/10/04 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the limitation of the plurality of insole layers of Grim not being "capable of being rearranged so as to be stacked in different orders", this is not persuasive. Since the different layers of Grim are completely detachable from one another, they are inherently capable of being

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rearranged so as to be stacking in different orders. It is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In re Swinehart, 169 USPQ 226 (CCPA1971).

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner \_\_\_\_ of Art Unit \_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson  
Primary Examiner  
Art Unit 3728